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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/541,088      | 03/31/2000  | Masako Asamura       | 1190-0456P          | 4023             |

2292 7590 04/23/2003

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EXAMINER

LEE, Y YOUNG

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2613

DATE MAILED: 04/23/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/541,088

Applicant(s)

Masako Asamura et al



Examiner

Y. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 14, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2, and 6-30 is/are pending in the application.
- 4a) Of the above, claim(s) 1, 2, 9-18, and 23-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8, 19-22, and 27-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☒ Certified copies of the priority documents have been received in Application No. 08/925,074.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/14/03 has been entered.

### ***Election/Restriction***

2. Applicant's election without traverse of embodiment V, Figures 17-23 in Paper No. 6 is acknowledged.

3. Claims 1, 2, 9-18, and 23-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected embodiment, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 6.

### ***Priority***

4. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/925,074, filed on 9/8/97.

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***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 6-8, 19-22, and 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimoda (5,440,345).

Shimoda, in Figures 2-5, 7-11, 15-18, 21-23, and 25-28, discloses the same digital VTR for magnetically recording and replaying digitally transmitted bit stream in a predetermined recording format as specified in claims 6-8, 19-22, and 27-30 of the present invention, comprising division number setting means 208, responsive to a bit stream input including a predetermined number M of transport packets as a unit 204, wherein M is an integer, wherein N sync blocks are related to the transport packets such that N is not equal to M, and wherein N is an

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integer; the division number setting means setting the division number so that M transport packets are divided into N sync blocks to form the recording format (Figs. 27 and 28); header appending means 205 for generating a first header for each of the M transport packets and appending the first header to each of the N sync blocks; and format forming means 208 for forming N consecutive sync blocks from the data after the division of the bit stream.

With respect to claims 7, 8, 19-22, 28, and 30, Shimoda also discloses a data identifying circuit 63 for decoding header information of the input bit stream; a data extraction circuit 61 for extracting, from the input bit stream, a series of encoded data of image blocks used for fast replay, based on the decoded header information (Fig. 7); a decoder 22 for decoding the series of coded data of the input bit stream and for outputting a transformation coefficient belonging to the decoded data; a coefficient counter 64 for counting the number of transformation coefficients; a data amount control circuit 15 for receiving the coefficient count number from the coefficient counter in such a way that the data length of the extracted, coded data of an integer number image blocks is reduced to a data amount which can be recorded in K sync blocks in the predetermined format, wherein K is a positive integer; detecting means 217 for detecting intra-picture data in the input bit stream; forming means 219 for forming fast replay data from the intra-picture data; wherein a header appending means 72 appends a first header for discriminating the fast replay data from normal replay data, and a second header for discriminating, within the normal replay data, the intra-picture data and non-intra-picture data from each other; recording means 210 for recording the fast replay data together with the normal

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replay data on a magnetic recording medium 211; replay means 212 for replaying normal replay data, together with fast replay data from the magnetic recording medium 211; separating means for separating the normal replay data, by checking the headers 81 appended to the normal replay data selected by the separating means (Fig. 18); storage means 86 for storing the intra-picture data, by checking the second header 54 appended to the normal replay data selected by the separating means; and switching means 89 for selectively outputting the normal replay data or the intra-picture data stored in the storage means, depending on whether a replay mode is normal replay or still replay.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 6-8, 19-22, and 27-30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications intended for entry)


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(for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

**Or:**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington. VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.

  
**Y. LEE**  
**PRIMARY EXAMINER**

Y. Lee/yl  
April 21, 2003